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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,326	11/14/2001	Thao D. Hovanky	PA2089US	8287
22830	7590	06/20/2005	EXAMINER	
CARR & FERRELL LLP			HO, TUAN V	
2200 GENG ROAD			ART UNIT	
PALO ALTO, CA 94303			PAPER NUMBER	

2615

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,326

Applicant(s)

HOVANKY, THAO D.

Examiner

Tuan V. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 10 and 11 are rejected under the judicially created doctrine of double patenting over claims 1-4 and 5 of U. S. Patent No. 6,356,308 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

With regard to claim 1, claim 1 is encompassed by limitations of Patent claim 1 since the scope claim 1 is broader than the one of patent claim 1.

With regard to claim 2, 5 and 6, claims 2, 5 and 6 are encompassed by Patent claims 2, 3 and 4.

With regard to claim 3, claim 1 is encompassed by limitations of Patent claim 3; wherein claimed second voice coil actuator is met by the second voice coil of Patent claim 1.

With regard to claim 4, claim 4 is encompassed by limitations of Patent claim 1; wherein the coil assembly is met by the general planar coil assembly.

With regard to claim 7, claim 7 is encompassed by limitations of Patent claim 5 since the scope claim 7 is broader than the one of patent claim 5.

With regard to claim 10, claim 10 is encompassed by Patent claim 6.

With regard to claim 11, claim 11 is encompassed by Patent claim 7.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski, Jr. et al (US 5,717,512) in view of Okada et al (US 5,897,226).

Chmielewski, Jr. discloses in Figs. 5 and 8 an image steering and focusing device controlling a mirror device (mirror 34), which comprises the means for supporting an article be positioned (mirror holder has an axis A, col. 4, lines 18-63), base, mechanically coupled to the supporting means such that the supporting means and the article are rotatable about a first rotation axis relative to the base (top and bottom arms and arm 38 hold the frame and mirror via axis A as shown in Fig. 5; where the mirror can be tilted), and voice coil actuator (motors 76 and 70 can be voice coil motors, col. 8, lines 28, col. 5, lines 25-30), except that the voice coil actuator including a voice coil assembly fixedly coupled to one of the supporting

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means or the base, and a set of permanent magnets fixedly coupled to the other of the supporting means or the base.

Chmielewski, Jr. does not explicitly disclose any voice coil actuator, voice coil assembly and set of magnets. However, Okada et al teaches using voice coil motor including two planar coils 56a and 56b and set of magnet 57 so as to move camera lens in different directions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the motors of Chmielewski, Jr. et al with the voice coil motor including magnets of Okada et al in order to obtain voice coil actuator that can move the mirror in different direction such as pan and tilt; where the magnets can be fixed at the at the arms or the holder. The substitution of the motors of Chmielewski et al with the voice coil motors of Okada et al would allow the mirror to move different directions with more accuracy and make the camera more compact since voice coil motors have smaller size than ordinary motors.

With regard to claim 10, in the combination of Chmielewski, Jr. et al in view of Okada et al, there must be a angle controlling circuit so as to control the angle rotation of the mirror; otherwise, the mirror will point to an undesired object.

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5. Claims 8, 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hosoe et al discloses focusing system of an optical lens that includes actuator motors.

Hart discloses a surveillance camera that includes base and supporting device.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

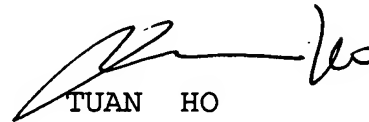
If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600.



TUAN HO

Primary Examiner

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